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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/904,831 07/16/01 METTRIE

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EXAMINER

DOLYON, I

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

10/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/904,831

Applicant(s)

METTRIE ET AL.

Examiner

Lorna M. Douyon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-34 and 36-71 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/875,469.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 20) ☐ Other: _____

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Claim Rejections - 35 USC § 112

1. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is a duplicate of claim 35. It is suggested that this claim be deleted or be further limited.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 30-34 and 37-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US Patent No. 5,700,456), hereinafter “Dubief” in view of *International Cosmetic Ingredient Dictionary*.

Dubief teaches hair treating compositions which contain at least one ceramide and/or glyceramide, and at least one cationic polymer (see abstract). The cationic polymers may be of formula (III), which encompasses those of formulae (IV) and (V) as claimed (see col. 3, lines 43-52). The compositions may also contain thickening agents like NATROSOL PLUS (see col. 8, lines 36-45). Dubief also teaches that the compositions may also be used for the dyeing of keratinous fibers such as hair, in which case they contain oxidation dyes and/or direct dyes (see col. 9, lines 18-25). Dubief also teaches that the products can also be in the form of thickened liquids (see col. 9, lines 32-34). Dubief also teaches that the pH of the compositions is generally from 2 to 9 (see col. 8, lines 58-61). In Example 6, Dubief teaches a cream oxidation hair dyeing composition which contains a p-phenylenediamine oxidation base, m-phenylenediamine coupler, a cationic polymer as claimed in claim 46, and a reducing agent (sodium sulfite), wherein each component is present in the claimed amounts. The composition is mixed with an oxidant containing 20-volumes of hydrogen peroxide, and the mixture is applied to the hair in a hair dyeing process as claimed. Dubief, however, does not specifically teach (1) the claimed nonionic

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amphiphilic polymer to both the dye- and oxidant-containing compositions, their proportions, and (2) multi-compartment kits.

The *International Cosmetic Ingredient Dictionary* teaches that NATROSOL PLUS is cetyl (i.e. C₁₆) modified hydroxyethyl cellulose (see page 110, “cetyl hydroxyethylcellulose” entry).

With respect to difference (1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a thickened composition for the oxidative dyeing of hair which contains an oxidation dye precursor, coupler, direct dye, cationic polymer and cetyl hydroxyethylcellulose nonionic amphiphilic polymer as claimed, wherein each component is present in optimum amounts, and wherein the composition is mixed with a hydrogen peroxide oxidant and is applied to hair as claimed, because such compositions and processes fall within the scope of those taught by Dubief. Particularly, Dubief teaches that the oxidative hair dyeing compositions may be in thickened form, and teaches NATROSOL PLUS, which is cetyl hydroxyethylcellulose, as a preferred thickener, therefore, motivating those skilled in the art to select this specific thickener for use in a thickened hair dyeing composition.

Optimization of the amount of nonionic amphiphilic polymer added to such compositions would have been obvious to those skilled in the art in order to obtain the most effective thickening and hair dyeing results, (e.g. an amount which provides easy mixing and prevents dripping from the hair). See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re*

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Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With respect to difference (2), it would have been obvious to one of ordinary skill in the art to package Dubief's two-part compositions in multicompartment kits because Dubief suggests such kits by teaching separate oxidant- and dye-containing compositions prior to application. The Office holds the position that the claimed compositions and processes which contain and use the nonionic amphiphilic polymer in both the dye- and oxidant-containing compositions are patentably indistinct from Dubief's compositions because equivalent hair dyeing results would be obtained with Dubief's two-part composition, i.e., the application of an oxidation base, coupler, nonionic amphiphilic polymer and oxidant to the hair, absent a showing otherwise.

Allowable Subject Matter

5. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record teaches, discloses or suggests a composition for the oxidation dyeing of keratin fibers wherein the nonionic amphiphilic polymer is a cellulose containing at least one polyalkylene glycol alkyl ether group. Ascione, US Patent No. 5,670,137, although teaching at least hydroxyethylcellulose which may be Natrosol Plus Grade 330-CS or Amercell Polymer HM-1500, which is a hydroxyethylcellulose modified by a nonoxynyl

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(nonylphenol) group (see col. 2, lines 17-58) in anhydrous dentrifice composition, fails to teach the latter modified cellulose in oxidation dyeing of keratin fibers.

Response To Applicants' Arguments

6. Applicant's arguments filed on October 10, 2001 have been fully considered but they are not persuasive.

With respect to Dubief in view of *International Cosmetic Ingredient Dictionary*, Applicants argue that Dubief is not principally directed to oxidation dye compositions, but rather, to “non-washing compositions intended for the treatment and protection of hair, based on ceramide and/or glycoceramide and on cationic polymers” (see Dubief, col. 1, lines 51-54). Applicants also argue that although Dubief teaches that its “non-washing composition” can be used for dyeing of keratinous fibers, In Example 6, Dubief’s two-part oxidative hair dye composition is not thickened with cetyl hydroxyethylcellulose and further argues that this example is in a thickened form, i.e., cream, despite the absence of cetyl hydroxyethylcellulose. Applicants then argue that one of ordinary skill in the art would not be motivated to modify the teachings of Dubief and add a thickener to the dye composition disclosed therein because the reference itself specifically discloses that a thickener is not needed.

The Examiner respectfully disagrees with the above arguments because Dubief not only teaches “non-washing compositions” but also compositions which require rinsing, see Examples 2 to 5 under col. 10, lines 38-40, wherein it is stated that the compositions were left in place for 5

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minutes and the hair was then rinsed in running water. See also Example 6 under col. 11, line 22. Even though Dubief does not exemplify the use of cetyl hydroxyethylcellulose in his two-part oxidative hair dye composition in Example 6, a reference is not limited to working examples, see *In re Fracalossi* 215 USPQ 569 (CCPA 1982). The fact remains that the compositions of Dubief, which can also be used for the oxidation dyeing of keratinous fibers (see col. 9, lines 18-20) can contain thickening agents such as NATROSOL PLUS (see col. 8, lines 36-45), which is cetyl hydroxyethylcellulose. Accordingly, with these teachings, a person of ordinary skill in the art would be motivated to incorporate cetyl hydroxyethylcellulose into the composition of Dubief for use in oxidation dyeing of keratinous fibers.

7. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references are considered cumulative to or less material than those discussed above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (703) 305-3773. The examiner can normally be reached on Mondays-Fridays from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Technology Center is:

(703) 305-3599 - for Official After Final faxes
(703) 305-7718 - for all other Official faxes.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

October 22, 2001

Lorna M. Douyon
Lorna M. Douyon
Primary Examiner
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